

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
Su et al.)	Confirmation No.: 7188
)	
Application No.: 10/091,237)	Examiner: Stevens, R.
)	
Filing Date: March 04, 2002)	Art Unit: 2162
)	
For: METHOD AND SYSTEM OF)	
DOCUMENT TRANSFORMATION)	
BETWEEN A SOURCE EXTENSIBLE)	
MARKUP LANGUAGE (XML) SCHEMA)	
AND A TARGET SCHEMA)	
)	

Hon. Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO THE REQUIREMENT FOR INFORMATION

Dear Sir:

In response to the non-final Office Action mailed May 21, 2007, Applicants respectfully submit this Response to the Requirement for Information.

Examiner: Stevens, R.
Art Unit: 2162

REQUIREMENT FOR INFORMATION

The instant Office Action includes a Requirement for Information under 37 CFR §1.105 regarding the ownership of the instant application and the right to assign such ownership interests.

Summary

At the time of the development of the Applicants' subject matter, all development was performed under the funding and obligation of Hewlett-Packard Company, and each inventor was under an obligation to assign the subject matter to Hewlett-Packard Company. Inventor Su was an intern with Hewlett-Packard company, under the supervision of inventor Kuno. Inventor Su was a student at Worcester Polytechnic Institute (WPI) during the internship. Inventor Rundensteiner was a professor at WPI, and was inventor Su's advisor. Both inventor Su and inventor Rundensteiner were under an obligation to assign the subject matter of the instant application to Hewlett-Packard Company.

Referring to the statement that "[t]his work was support in part by several grants from the NSF" in the publication "Automating the Transformation of XML Documents," Applicants submit that the subject matter of the instant application was not supported in any part by the NSF. Inventor Rundensteiner has a relationship with the NSF, and the statement of support was in reference to support of her career and sponsoring other aspects of her research. Furthermore, the statement thanking IBM "for support of Hong Su in terms of a Corporate Fellowship from 2001 to 2002" also was to convey thanks to

IBM for the career development of inventor Su, and that the development of the subject matter of the instant application was not supported in any part by IBM.

Response to interrogatories

1. Inventor Su was a student of Worcester Polytechnic Institute during the development of the Applicants' subject matter. Inventor Rundensteiner was an employee of Worcester Polytechnic Institute during the development of the Applicants' subject matter, and was the advisor to inventor Su. The Applicants' subject matter was developed while inventor Su was an intern at Hewlett-Packard Company, under the supervision of inventor Kuno.
2. Inventors Su and Rundensteiner were under an obligation to assign the subject matter of the instant application to Hewlett-Packard Company.
3. The Applicants' subject matter was not developed under a joint research agreement.
4. Federal funds were not used in the development of the Applicants' subject matter.
5. The Applicants' subject matter was developed solely under the support of Hewlett-Packard Company, and IBM has no rights, ownership or otherwise, in the Applicants' subject matter.

6. There was no research agreement in place between IBM and Hewlett-Packard Company. The Corporate Fellowship of inventor Su by IBM was not related to the Applicants' subject matter.

Response to Documents Requested

1. Applicants respectfully submit that any agreements between inventor Su and WPI and inventor Rundensteiner and WPI are unknown or not readily available to Applicants. Moreover, Applicants note that inventors Su and Rundensteiner were under an obligation to assign the Applicants subject matter to Hewlett-Packard Company.
2. Applicants respectfully submit that agreements pertaining to a joint research agreement to support the development of the Applicants' subject matter are unknown or not readily available to the Applicants.
3. Applicants respectfully submit that NSF grants used to support the development of the Applicants' subject matter are unknown or not readily available to the Applicants.
4. Applicants respectfully submit that agreements pertaining to federal funding to support the development of the Applicants' subject matter are unknown or not readily available to the Applicants.
5. Applicants respectfully submit that agreements between inventor Su and IBM are unknown or not readily available to the Applicants.

CONCLUSION

Applicants respectfully submit that the instant Response to the Requirement for Information has been made with candor and good faith under 37 CFR §1.56.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Respectfully submitted,

WAGNER BLECHER L.L.P.

Dated: 07/01/2008

/John P. Wagner, Jr./
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